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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,350	08/08/2001	Soren Ebdrup	5738.204-US	3619

7590 11/19/2003

Reza Green, Esq.
Novo Nordisk of North America Inc.
Suite 6400
405 Lexington Avenue
New York, NY 10174-6401

EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 11/19/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application N .

09/924,350

Applicant(s)

EBDRUP ET AL.

Examiner

Venkataraman
Balasubramanian

Art Unit

1624

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See attached Advisory Action.

ADVISORY ACTION

The response filed 10/15/2003 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered for the following reasons.

Priority

Applicant's provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 19, 21 and 23 of this application. Several species embraced in the instant claim 19, 21 and 23 are not enabled in the provisional application. The priority document has no enablement for the said species, composition and method of use. Hence, applicants are not granted priority to claims 19 21 and 23 for reasons said forth as above.

Applicants' response is considered but not persuasive. Examination of the provisional application in question, earlier clearly showed that the instant application and the provisional are not the same and that instant application has subject matter not embraced in the provisional application. Hence applicants cannot claim benefit of priority to those material not in the provisional application.

Claim Rejections - 35 USC § 103

Claims 1-12 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pirotte et al. 5,459,138 in view of Nielson et al. WO 97/26265 (equivalent US 5,889,002) for reasons of record.

Applicants' traversal to overcome this rejection is not persuasive. Following apply:

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1. Applicants argue that compounds taught by Pirotte et al. are not same as instant compounds. But instant claims are process claims and the reactive centers are just the same. Applicants have not shown that variation in the core A, i.e. thieno of instant to pyridine taught by Pirotte et al. would alter the course of the reaction. Prior art of record does not support such a contention.
2. Applicants also argue that the electronegative of instant core and the cited reference core are different and would alter the course of the reaction. But applicants have not provided any comparative data to show that is indeed the case.
3. Furthermore, applicants original claim 1 included so many variation in the A core yet was presented as viable process for all such cores. Hence applicants' argument lacks factual support.
4. Applicants also argue that the instant utility is different from the prior art. This is not a valid argument. One trained in the art would be motivate to combine these prior art make compounds based on the combined process taught and use the compounds for the utility taught therein.

Hence this rejection is maintained.

Claims 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielson et al. WO 97/26265 (equivalent US 5,889,002) for reasons of record.

Again, applicants' argument is not persuasive. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a

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sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In the instant case, Nielson et al., as noted in the previous office action, teaches equivalency of isomeric thiadiazines made with those generically claimed on page 3 for formula I. There is a clear-cut guidepost for making either of the isomeric thieno-thiadiazines. Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to make both the isomeric compounds variously substituted in thieno-thiadiazine ring as permitted by the reference and expect resulting compounds (instant compounds) to possess the uses taught by the art in view of the equivalency teaching outline above.

Hence this rejection is proper and is maintained.

Double Patenting

Claims 18-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 5,889,002.

Claims 18-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,329,367.

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These two rejections are same as made in the previous office action but are now limited compounds, composition and method of use. Applicants' argument to overcome these two rejections is not persuasive. Both the references teach thionofused-1,2,4-thiadiazine, composition and method of use which overlaps with instant claimed subject matter.

For these reasons the rejections made in the previous office action are maintained.

No claims are allowed.

Conclusion

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is Mukund Shah whose telephone number is (703) 308-4716.

The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

V. Balasubramanian
Venkataraman Balasubramanian

11/13/2003